



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

PW

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/052,002 | 01/17/2002 | John A. Reeve | MAC - 199 | 9163 |
| 7590 | 10/04/2004 | | EXAMINER | |
| Robert L. McKellar Suite #2 816 West Wackerly St. Midland, MI 48640-2730 | | | MARKOFF, ALEXANDER | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1746 | |

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-------------------------------|------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/052,002 | REEVE, JOHN A. | |
| | Examiner Alexander Markoff | Art Unit 1746 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 17 January 2002.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
 4a) Of the above claim(s) 3-6 and 9-12 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1,2,7,8 and 13-29 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 1/17/02.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2, 7, 8 and 13-29 are drawn to a method of modification of substrates, classified in class 8, subclass 115.68.
 - II. Claims 3, 4, 11, and 12, drawn to a method, classified in class 8, subclass 115.68.
 - III. Claims 6, 6, 9 and 10, drawn to a method, classified in class 8, subclass 115.68.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Groups I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation. The invention of Group I requires application of dianinon prior to treatment with silicon containing material, the invention of Group II requires this application during the treatment, the invention of Group III requires this application after the treatment.
3. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and Group III, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Robert L. McKellar a provisional election was made without traverse to prosecute the invention of Group I, claims 1, 2, 7, 8, and 13-29. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-6 and 9-12 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1, 2, 7, 8, and 13-29 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the specific substrates, specific silicon containing material and specific dianions, does not reasonably provide enablement for any non specified substrates, materials and dianions. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The claims recite contacting of n on specified substrates with a silicone-containing material capable of reacting at or near the surface. The claims do not specify the "reacting". The claims do not recite with what the material should be capable of reacting. The claims do not even require the reacting.

The specification discloses only antimicrobial treatment of the specific substrates with specific antimicrobial agents. There is no disclosure or teaching regarding other treatments presented in the specification. The specification provides no guidance how

other treatments of different substrates can be determined. Without such guidance an ordinary artisan would not be able to practice the invention without undue experimentation.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 7, 8, and 13-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are indefinite because it is not clear whether or not the reacting of the material is required by the claims.

Claims 1, 2 and 13-29 are indefinite because it is not clear reacting with what the material should be capable of.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. US Patents 5,883,185, 6,048,368, 5,403361 are cited to show the state of the prior art with respect to methods of treating substrates with silicon containing materials.
11. US Patents 2,637,623 and 6,673,118 are cited to show the state of the prior art with respect to methods and compositions for treatment textiles with silicon containing materials and compounds comprising dianions. It is noted that the cited art does not

teach the sequential application of compounds comprising dianions and silicon containing materials.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Markoff whose telephone number is 571-272-1304. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on 571-272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alexander Markoff
Primary Examiner
Art Unit 1746

am

ALEXANDER MARKOFF
PRIMARY EXAMINER